

Serial No.: 09/715,725
Filing Date: November 16, 2000

REMARKS

Claims 26-30 are pending.

The Office Action mailed 17 July 2002 restricts Claims 26-30 between ten inventive groups. In their response to the restriction requirement filed 17 September 2002 Applicants pointed out what were believed to be obvious errors in the restriction requirement and provisionally elected, with traverse, Claims 27-30 directed to SEQ ID NO:8 in the event that a corrected restriction should be forthcoming.

The Office Action mailed 16 October 2002 finds Applicants' reply of 17 September 2002 to be non-responsive to the Office Action mailed 17 July 2002. In response, Applicants submit the present supplemental response to the 17 July 2002 Office Action.

Attached hereto is a set of the pending claims.

SUPPLEMENTAL RESPONSE TO RESTRICTION

The Office Action mailed 17 July 2002 restricts pending Claims 26-30 between ten inventive groups as follows:

Group I: Claims 26, 27, 29, 30, directed to SEQ ID NO:1

Group II: Claims 26, 27, 29, 30, directed to SEQ ID NO:3

Group III: Claims 26, 27, 29, 30, directed to SEQ ID NO:5

Group IV: Claims 26, 27, 29, 30, directed to SEQ ID NO:7

Group V: Claims 26, 27, 29, 30, directed to SEQ ID NO:9

Group VI: Claim 28, directed to SEQ ID NO:2

Group VII: Claim 28, directed to SEQ ID NO:4

Group VIII: Claim 28, directed to SEQ ID NO:6

Serial No.: 09/715,725
Filing Date: November 16, 2000

Group IX: Claim 28, directed to SEQ ID NO:8

Group X: Claim 28, directed to SEQ ID NO:10

The Office Action mailed 17 July 2002 states that "Claims 27, 29-30 will be examined as the amino acid sequence is drawn to the protein encoded by the nucleic acid sequence selected". Applicants are unclear as to the meaning of this statement, and respectfully reiterate that Claims 27-30 do not recite SEQ ID NOs:1, 3, 5, 7, or 9. Rather, these claims are drawn to amino acid sequences set forth by SEQ ID NOs: 2, 4, 6, 8, and 10.

Applicants hereby elect Group IV, Claims 26, 27, 29 and 30. To the extent that these claims require the election of SEQ ID NO:7 (e.g., Claim 26) and the election of SEQ ID NO:8 (e.g., Claims 27, 29 and 30) Applicants so elect. This election is made with traverse for reasons of record, as well as the reasons given below.

Regarding claims directed to nucleotide sequences encoding different proteins, the MPEP states at § 803.04:

Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. It has been determined that normally ten sequences constitute a reasonable number for examination purposes.

Further, as set forth in the MPEP at § 803.01, there must be a serious burden on the examiner if restriction is required. The MPEP further states at § 803.01 that a *prima facie* showing established by explanation of separate classification, or separate status in the art, may be rebutted.

Applicants emphasize that sequence identifiers recited in the instant claims describe ING2 splice variants having clearly related amino acid sequences. Further, Applicants point out that SEQ ID NO:8, corresponding to ING2 isoform 4, comprises the amino acid sequences of the other recited ING2 isoforms (1-3 and 5; SEQ ID NOs: 2, 4, 6, and 10, respectively). Similarly, SEQ ID NO:7, corresponding to ING2 isoform 4, comprises the nucleotide sequences of the other recited ING2 isoforms (1-3 and 5; SEQ ID NOs:1, 3, 5, and

Serial No.: 09/715,725
Filing Date: November 16, 2000

9, respectively). Applicants submit that a search directed to SEQ ID NOs:2, 4, 6, and 10 would not significantly raise the Examiner's burden above that of a search directed to SEQ ID NO:8 alone. Similarly, Applicants submit that a search directed to SEQ ID NOs:1, 3, 5, and 9 would not significantly raise the Examiner's burden above that of a search directed to SEQ ID NO:7 alone.

Finally, Applicants point out that Claim 28 properly depends from Claim 27 which is drawn to SEQ ID NOs:2, 4, 6, 8 and 10. Accordingly, Applicants respectfully request examination of Claim 28 together with Claims 26, 27, 29 and 30 on the merits.

Respectfully submitted,
DORSEY & WHITNEY LLP

Dated: 10/31/02


Robin M. Silva, Reg. No. 38,304
submitted under 37 C.F.R. 1.34(a)

Four Embarcadero Center, Suite 3400
San Francisco, CA 94111-4187
(415) 781-1989